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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/594,058   | 06/18/2007  | Nobutaka Okabe       | 60626.00021                     | 8894                        |
| 32294 7590 09/21/2010<br>SQUIRE, SANDERS & DEMPSEY L.L.P.<br>8000 TOWERS CRESCENT DRIVE<br>14TH FLOOR<br>VIENNA, VA 22182-6212 |             |                      | EXAMINER<br>PATs, JUSTIN        |                             |
|  |             |                      | ART UNIT<br>3623                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>09/21/2010 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPGENERALTYC@SSD.COM  
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|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/594,058 | <b>Applicant(s)</b><br>OKABE ET AL. |  |
|                              | <b>Examiner</b><br>JUSTIN M. PATS    | <b>Art Unit</b><br>3623             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-18 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 11–12, 15–16, drawn to a system and method for preparing a report containing actions for achieving one or more themes, comprising comparison of a theme to a check item.

Group II, claim(s) 13–14, 17–18, drawn to a system and method for preparing a report containing actions for achieving one or more themes, comprising comparison of current and past badness values.

2. The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The common technical features between Groups I and II are as follows:

A system for preparing a report containing actions for achieving one or more themes, comprising:

a first database for storing one or more check items for reviewing achievement of each theme, one or more check result indications given to respective check items by an acting department, a plurality of actions for achieving said one or more themes, and evaluation values given to respective actions indicating the degree of effectiveness of respective actions;

a second database for storing past reports containing past themes and the actions used for achieving the past themes; and

a computer for preparing the report, the computer being programmed to,

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compare past and current data relating to a badness indication and increasing or decreasing the evaluation value of the action for achieving said one or more themes based on the comparison

select an action having a high evaluation value among all the actions that relate to check items carrying check result indications needing actions; and

prepare a current report containing one or more selected actions and one or more themes corresponding to a check item carrying a check result indication needing action.

3. These elements cannot be special technical features under PCT Rule 13.2 (*see also* MPEP 1801–II) because the elements are shown in the prior art: Ammerman et al., U.S. Pub. 2003/0115094 [hereinafter Ammerman], in the art of evaluating the performance of a business, teaches a system for preparing a report containing actions for achieving one or more themes, comprising: a first database for storing (Fig. 1, ref. 16, Data Storage Device; ¶¶ 0085–86) one or more check items for reviewing achievement of each theme (¶ 0032, “The present invention provides an apparatus and methods for evaluating the performance of a company that provides a plurality of preselected responses to each query that are objectively answerable based on observed behaviors of the employee . . . . The interface to presents a plurality of inquiries regarding the performance of an employee of the business and to receive a pre-selected behavior based response for each of the plurality of inquiries. The behavior based response is selected from a plurality of a behavior based responses provided with each of the plurality of inquiries.”), one or more check result indications given to respective check items by an acting department (*id.*, discussing responses), a plurality of actions for achieving said one or more themes (*id.*, discussing the inquiries and responses relating to employee behavior), and evaluation values given to respective actions indicating the degree of effectiveness of respective actions (*id.*, *see*

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*also* ¶ 0032, “Each of the a behavior based responses is assigned a value.”; ¶ 0033, “The program assigns a value to each of the plurality of behavioral based responses.”);

a database for storing past reports containing past themes and the actions used for achieving the past themes (¶ 0061, “A starting point and a map to the entire organization to completion can be made with the type and number of reports desired for the organization as a whole and by each area and department and area of organization that can be updated and amended as each department is consulted on the development of the software.”; ¶ 0064, “Specific reports can then be determined, with links to the organization's intranet to the performance evaluation site that can provide a seamless connection.”; ¶¶ 0087–0088, 91, discussing data from reports being stored in data storage device 16); and a computer for preparing the report, the computer being programmed to (Fig. 1, ref. 18, Processor), compare past and current data relating to a badness indication (¶ 102, discussing comparison of current performance and past action plans) and increasing or decreasing the evaluation value of the action for achieving said one or more themes based on the comparison (¶¶ 0099–101, discussing generation of an action plan that can summarize needs and accomplishments; *see also* ¶ 0021, discussing performance evaluation comprising exceeds expectations, meets requirements, and needs improvement valuations); select an action having a high evaluation value among all the actions that relate to check items carrying check result indications needing actions (¶ 0107, discussing rule compliance analysis by selecting behaviors, wherein score of 4.0 or more indicates rule compliance); and prepare a current action plan containing one or more selected actions and one or more themes corresponding to a check item carrying a check result indication

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needing action (§§ 0096, 98–99, discussing generating action plan identifying training needs for performance areas of 3.0 or less).

Ammerman does not explicitly teach the database for storing past reports being a separate, second database. However, absent evidence of new or unexpected results, it is not inventive in terms of patentability to provide one or more databases with one or more known sets of data and add (or subtract) an additional number of databases to comprises all or part of the same data. A modification increasing the number of databases is analogous to making functions, structures, or actions separable. When the difference between the claimed invention and the prior art is that the prior art does not disclose an element as separable, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element separable to achieve a predictable result. See MPEP § 2144.04 V.C. and *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). It is desirable to provide additional databases to promote enhanced data organization and improved operational efficiency by distributing necessary processing power amongst multiple repositories.

Ammerman does not explicitly teach the current assessment being in report format. However, reports are old and well known in performance analysis as taught by Ammerman as discussed above. As such, because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself--that is in the substitution of a report for the action plan of Ammerman. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

Therefore, because the common technical features do not define a contribution over the prior art, it is determined that there is a lack of unity *a posteriori*.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention or species.

Should applicant traverse on the ground that the inventions have unity of invention (37 CFR 1.475(a)), applicant must provide reasons in support thereof. Applicant may submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. Where such evidence or admission is provided by applicant, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on M-F, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/  
Examiner, Art Unit 3623